REMARKS

Applicants hereby add new claims 24-28. Accordingly, claims 1-28 are pending in the present application.

Claim 15 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of co-pending Application No. 09/648,664 to Harper et al. in view of U.S. Patent No 6,333,790 to Kageyama. Claims 1, 4, 6-8, 11-12, 14-15, 17, 19, and 21-23 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,430,711 to Sekizawa in view of U.S. Patent No. 5,517,617 to Sathaye et al. Claim 3 stands rejected under 35 USC 103(a) for obviousness over Sekizawa and Sathaye and further in view of U.S. Patent No. 6,272,472 to Danneels et al. Claims 2, 5, 9-10, 13, 16, 18, and 20 stand rejected under 35 USC 103(a) for obviousness over Sekizawa and Sathaye and further in view of U.S. Patent No. 6,625,581 to Perkowski.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Applicants submit a Terminal Disclaimer with respect to the obviousness-type double patenting rejection of claim 15. Applicants request withdrawal of the rejection for at least this reason.

Referring to claim 1, the Examiner relies upon the teachings of Satheye and Sekizawa in support of the obviousness rejection of claim 1. Even if combined, the teachings of Satheye and Sekizawa fail to disclose or suggest positively-recited limitations of claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Sekizawa is directed towards a system and method for monitoring a plurality of network printers connected via a computer network. Col. 18, line 45 - col. 19, line 35, make clear that different areas are provided corresponding to 2a-2c as

shown in Fig. 1 and such represent a customer store, business department, or the like. The arrangement includes plural agent units 10 in respective areas 2a-2c and a console unit 20 corresponds to an agency for selling printers or manufacturer of printers. Agent units 10 get status information including information regarding consumables of printers within the respective areas 2a-2c. As set forth in col. 19, lines 27+ the agent unit 10 adds the address of the console unit 20 to the status mail and sends the status mail to mail server 19 and unit 20 thereafter accesses the status mail from the server 19.

Initially, Applicants note that the disclosed configuration of Sekizawa is devoid of ***determining an electronic address for a consumables supplier appropriate to a geographical area within which a hard copy output engine is to be deployed*** as claimed in claim 1. Further, there is absolutely no need to determine the electronic address in view of the Sekizawa teachings. More specifically, the arrangement of Sekizawa already provides a system including the console unit 20 for receiving status regarding consumables. The printers provided within a respective area 2a-2c are associated with a respective agent 10 which is configured to communicate the status information to console unit 20. ***Agents 10 address the status communications for communication to console 20.*** Accordingly, there is no need to determine the electronic address as claimed since the agent 10 already has the address of the unit 20. Regardless of which area 2a-2c the printer is used in, the associated agent 10 is already arranged to communicate with the console unit 20 and there is no teaching of the determining the geographical area or the electronic address as claimed. The recited teachings identified in the office action are devoid of the claimed determining the electronic address inasmuch as the respective agent 10 already has the address of the console 20 which thereafter may process the communications. The interpretation of Sekizawa in the Office Action is directly contrary to the explicit reference teachings. The determining the geographical area or the electronic address of claim 1 is not taught nor suggested by the prior art. Accordingly, claim 1 is in condition for allowance.

The Office Action on page 4 correctly states Sekizawa fails to disclose the programming and storing the electronic address into non-volatile memory but relies upon the teachings of Sathaye to cure the deficiencies of Sekizawa. The reliance is misplaced.

There is no motivation to combine the teachings of Sathaye with the teachings of Sekizawa. The Examiner alleges on page of the Action that the modification to include the programming and storing of the electronic address in non-volatile memory is appropriate in order to keep track of addressable network entities. Applicants disagree.

More specifically, Sekizawa already teaches maintenance of addresses of counsel unit 20 within respective agents 10. There is no need or other motivation to also store addresses within memory of a hard copy output engine as claimed inasmuch as the agent 10 already provides such functionality. Accordingly, the rationale for the alleged motivation is already provided for and disclosed in Sekizawa and is therefore redundant. One of skill in the art would not look to Sathaye for meaningful teachings based at least upon the fact that Sekizawa already discloses the teachings for which Sathaye is allegedly presented.

Even if the references are combined, the combination of reference teachings fails to disclose or suggest limitations of claim 1. For example, claim 1 recites programming the electronic address into non-volatile memory of the hard copy output engine. Sathaye including the teachings of col. 1 is directed towards computer network entities including end stations and intermediate nodes. The computer network entity teachings of Sathaye provide absolutely no disclosure of *programming an electronic address for a consumable supplier into memory of the engine* as claimed. To the contrary, the stored addressed of Sathaye are for the entities themselves as made clear by the teachings of col. 1, lines 47-50 which provides that the address stored within an entity is the *physical address of the entity itself*. Sathaye only provides storage of an address within an entity which uniquely identifies the entity in which the address is stored. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest *programming an electronic address for a consumables supplier appropriate for a geographical area in which an engine is to be deployed within memory of the engine itself*. Numerous limitations of claim 1 are not taught nor suggested even if the references are combined and the rejection of claim 1 is improper for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as

well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 8, the Action correctly states on page 5 that the Sekizawa fails to disclose or suggest extracting an electronic address for a vendor from a non-volatile memory. Thereafter, the Examiner again erroneously relies upon the teachings of Sathaye in support of the rejection. In particular, the Examiner states that Sathaye teaches extracting an electronic address for a vendor from a non-volatile memory. Applicants disagree. First, *Sathaye is silent regarding any __vendor teachings__ but merely discusses generic network addressing in col.1*. Second, Sathaye teaches storage of an *address of an entity within the entity itself so the device may be uniquely identified at a subsequent moment in time and fails to teach any storage of an electronic address of an external device such as a vendor*. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 8.

In addition, there is no motivation to support the 103 rejection. Sekizawa already provides agent 10 which is responsible for addressing status communications to console 20. Thus, but for improper reliance upon Applicant's disclosure, there is absolutely no motivation to also redundantly store an address for a vendor within memory of an engine itself in view of the addressing by the agent 10 in communication with the printer. The only motivation improperly results from Applicants' disclosure and Applicants request withdrawal of the 103 rejection of claim 8 in the next Action for at least this additional reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, the Office Action states on page 7 that Sekizawa fails to disclose the storing and extracting of an electronic address for a supplier from a non-volatile memory and relies upon the teachings of Sathaye. The motivation in support of the combination is stated in order to keep track of addresses of addressable network entities and for a message to be delivered to the right place. Applicants disagree.

Agent 10 of Sekizawa is clearly taught to implement addressing of status

communications to the console unit 20. Further, the addressing of agent 10 insures the communications arrive at the right place (i.e., console unit 20). The motivational rationale is redundant, insufficient and results from the teachings of Applicants' disclosure. The 103 rejection of claim 15 is improper for at least this reason.

Further, even if the teachings are combined, Sekizawa discloses storage of an address of console unit 20 within an agent unit 10. Sathaye discloses storage of an address of an entity within the entity itself. Accordingly, even if the references are combined, the combination fails to teach or suggest the positively-claimed **memory in a hard copy engine and configured to *store data representing an electronic address for a supplier of consumables for the engine*** as claimed. Positively-recited limitations of claim 15 are not taught nor suggested and claim 15 is allowable for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 22, the processing circuitry is included in the hard copy output engine and is configured to extract the electronic address from memory of the hard copy output engine and to initiate communication with the supplier using the electronic address. Sekizawa teaches an external agent 10 implementing addressing operations and Sathaye merely discloses providing networked end stations and intermediate nodes with individual addressing identifiers so the networked devices themselves may be identified at a later moment in time. Even if the reference teachings are combined, the combination fails to teach or suggest *processing circuitry of the engine configured to extract and initiate* as claimed. Positively-recited limitations of claim 22 are not shown nor suggested by the prior art.

Referring to claim 23, Sekizawa is directed towards an arrangement wherein consumable status is communicated to console unit 20 by agents 10 and accordingly, there is no teaching of determining an electronic address for a supplier appropriate to a geographical area where the engine is deployed. Further, Sekizawa discloses agent 10 separate from the printer addressing the communications and

Sathaye discloses storage of an address of an entity within the entity itself, and accordingly, the combined teachings fail to disclose or suggest the *storing of the address of a consumable supplier within a non-volatile memory of an engine* as claimed.

Further, the agent 10 of Sekizawa implements communications with console 20. There are no teachings of a printer P of Sekizawa proactively initiating communication from the engine with a supplier but rather the communications to console unit 20 are provided by agent 10 and unit 20 may process the communications. Agents 10 of Sekizawa provide the communications not the engines as claimed. For example, see col. 19, line 23 stating that the agent 10 gets the status information and thereafter communicates the status information to the console. Numerous limitations of claim 23 are not shown nor suggested and claim 23 is allowable for at least this reason.

Agent 10 of Sekizawa is clearly taught to implement addressing of status communications to the console unit 20. Further, the addressing of agent 10 insures the communications arrive at the right place (i.e., console unit 20). Therefore, the motivational rationale presented in support of the rejection of claim 23 is redundant, insufficient and based upon Applicants' disclosure. The 103 rejection of claim 23 is improper for at least this reason.

The claims which depend from independent claim 23 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 24-28. Support for the new claims is found at least at Figs. 1 and 2 and related specification teachings of the originally filed application.
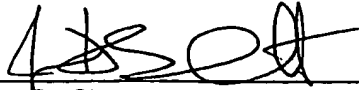
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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By: _____

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